

REMARKS**Paragraphs 1-11 of the Office Action**

Claims 1, 3-5, 8 and 10 are rejected under 35 U.S.C. §103(a) as being
5 unpatentable over U.S. Patent Number 6,851,827 to Clemente et al. in view of U.S.
Patent Number pub 2003/0133311 to Robertson. Claims 2, and 6-7 are rejected under 35
U.S.C. §103(a) as being unpatentable over Clemente et al. in view of Robertson et al. as
applied to claim 1 and further in view of U.S. Patent Number 6,499,859 to Petzl et al.

It is respectfully submitted to the Examiner that claim 1 is not anticipated by
10 Clemente or any of the prior art patents. The applicant originally claimed:
a housing having a front side, a back side and a peripheral wall extending
between said front and back sides, *said front side having a cavity
extending therein*;
a panel having a first side and a second side, said panel being removably
15 mounted in said cavity, *said panel having an outer perimeter
having a size and shape substantially equal to a size and shape of
an inner perimeter of said cavity*, wherein said first side may be
positioned against a back wall of said cavity such that said inner
perimeter of said cavity abuts said outer perimeter of said panel;
20 *a plurality of light emitters being attached to said second side of said
panel*;
*a first electrical conduit being mounted on said back wall, a second
electrical conduit being mounted on said first side of said panel,*
said first electrical conduit being positioned for electrically
25 coupling with said second electrical conduit when said panel is
positioned within said cavity, said second electrical conduit being
electrically coupled to said light emitters; and
a power supply being mounted within said housing, said power supply
being electrically coupled to said first electrical conduit.

30 Original claim 1, emphasis added. Clemente does not show a front side having a cavity
therein. Clement shows a peripheral wall attached to a back wall to define an interior of
the housing into which the light emitters are positioned. Thus, claim 1 is not anticipated
by Clemente. The Examiner later includes Petzl to show a hinged housing wherein lights
35 are mounted in the front wall. However, simply finding the elements of a claim is not
enough, there must be motivation to make the combination.

'Obviousness cannot be established by combining the teachings of the prior art to
produce the claimed invention, absent some teaching or suggestion supporting the

5 combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

10 In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)). Why would Clemente add a divided housing including hinged portions of that housing when Clement already has a removable front cover 130? The removable nature of the front cover 130 allows a user of the Clemente device to remove both the light emitters and power supply at the same time. Applicant's device does not have this advantage but has a different advantage of allowing a person to leave
15 the light casing intact while the power supply is being changed. Further, Clemente was filed after Petzl was published so it cannot be said that Clemente did not know about Petzl and certainly cannot be said that Clemente did not know about hinged openings. Further, Clemente intentionally used a screwed on cover and gasket combination for the purpose of providing a watertight seal. "The lamp retainer provides a compressive load
20 that forces the bulb and gasket against the shoulder of the front cover to produce a watertight seal." Column 3, lines 3-6. Thus, a housing having a break therein and having hinged portions therefore goes against the teachings of Clemente.

The Examiner then states that "the motivation of using a connector plug instead of just the wires of Clemente et al. is that removing and reattaching a connector plug is
25 easier than removing and reattaching wires through the panel and into the LEDs." That is correct, however that is exactly why the applicant provided this structure and it is the applicant who provided the motivation for the Examiner's argument. "Additionally, due to the nature of the use of the device, the device should include an efficient method of removing the LEDs mounted within the device so that they may be replaced if they are
30 damaged." Applicant's application, page 2, lines 28-30. The applicant provided the motivation required for the Examiner's analysis. This is hindsight reconstruction and is not permissible. Further, it is submitted that the entirety of the classified patents previously issued by the Patent and Trademark Office is at the command of the

Examiner. However, in the present case, the Examiner has not provided the applicant with any prior art patents or other reproducible evidence showing that a removable panel with multiple light emitters is a known equivalent to existing prior art or an obvious combination of known features taken from the prior art. Instead the Examiner has merely
5 provided an unsupported statement apparently based on the personal beliefs or personal knowledge of the Examiner.

10 "If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state" *In re Malcolm*, 129 F.2d 529, 54 USPQ 235 (CCPA 1942). If the applicant traverses such an assertion [of official notice by the examiner,] the examiner should cite a reference in support of his or her position. MPEP 2144.03.

Therefore, it is submitted that the Examiner should now produce at least one prior art
15 reference in support of the assertion that such a structure is in fact well known in the art.

With respect to claim 3, the applicant has included light emitters that extend beyond the cavity to allow their viewing by more than 180 degrees. This allows them to make a more effective rescue light. As mentioned above, Clemente has a structure that encourages a watertight seal for containing the light emitters. Thus, Clemente teaches
20 against light emitters that extend outwardly of the housing.

For the above reasons, claims 1-15 are believed to be in condition for allowance.

Withdrawal of the rejection is respectfully requested by the applicant.

Paragraphs 15-16 of the Office Action

25 Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Clemente et al., Robertson et al., and in further view of U. S. Patent No. 6,663,260 to Tieszen.

That the Examiner has found openings through something in which a light emitter is positioned is not enough. That is not what the applicant has claimed. The applicant has claimed a window through which the light emitters extend. First, the light ring 12 or
30 Tieszen shows a mounting, not a window. Of course there must be openings in the mounting for the light emitters 24 to be positioned or it would not be a mounting. Second, the light emitters 24 of Tieszen do not extend outwardly from the window. The applicant has claimed light emitters that extend outwardly of the cavity and a window

attached to the front side. Therefore, the light emitters must also extend outwardly through the window. In any event, the combination cannot be motivated by the prior art as the prior art specifically requests a watertight construction and openings through any part thereof would run contrary to these teachings. For this reason, claim 9 is believed to
5 be in condition for allowance.

The applicant respectfully requests withdrawal of the rejection.

Paragraphs 17-21 of the Office Action

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over
10 Clemente et al., Robertson et al., and Tieszen as applied to claim 9 above, and further in view of U.S. Patent Number Des. 354,577 to Cota et al. Claims 12-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Clemente et al. in view of Robertson et al. and further in view Costa et al.

It is respectfully submitted that Cota is a “clip-on flasher light” while Clemente is
15 a “submersible lantern.” There is no motivation to add a clip to the lantern, as Clemente’s device is to be handheld for use under water. Clemente surely knew of clips and the lack of one on the Clemente device is evidence of nonobviousness.

The applicant respectfully requests withdrawal of the rejection.

20 **Paragraph 22-24 of the Office Action**

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Clemente et al. in view of Robertson et al., in view of Petzl et al., in view of Tieszen et al. and further in view Costa et al.

For the reasons stated above, claim 14 is believed to be in condition for
25 allowance.

The applicant respectfully requests withdrawal of the rejection.

Paragraphs 25-29 of the Office Action

Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over
30 Clemente et al. in view of Tieszen et al. and further in view Costa et al. Claims 16-17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Clemente et al. in view of

Tieszen et al. and Cota et al. as applied to claim 15 above, and further in view of Petzl et al.

Claim 16 has been cancelled.

For the reasons stated above, claims 15 and 17 are believed to be in condition for
5 allowance.

The applicant respectfully requests withdrawal of the rejection.

CONCLUSION

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In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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